

REMARKS

1. Brief Review of One Embodiment of Applicants' Invention

In one embodiment, the present invention is directed to a gaming apparatus including a housing and a plurality of display characters with at least one of the display characters being configured to move from a first position to a second position to display at least one indicium, where the indicium appears on the at least one display character. The gaming apparatus further includes a controller in communication with at least one of the plurality of display characters and is configured to direct movement of the display character. The controller also generates a random number and a corresponding game outcome based on the random number. The controller is configured to move the at least one display character from its first to its second position to display the indicium that corresponds to the game outcome. In another embodiment, the indicium is hidden from view of the player when the display character is in the first position and is viewable by the player when in the second position.

2. Rejection of claims 1-3, 9, 17, 19, 33, 34, 37 and 45 under 35 U.S.C. §103(a) as being unpatentable over Fey (*Slot Machines, A Pictorial History of the First 100 Years*, Liberty Bell Books, 1983) in view of Baerlocher (U.S. Patent No. 6,336,863).

Previous claims 1-3, 9, 17, 19, 33, 34, 37 and 45 were rejected under 35 U.S.C. §103(a) as being obvious over Fey in view of Baerlocher. Applicants respectfully traverse the rejection.

Based on the amendments to independent claims 1, 33 and 45 requiring that the indicia representing the game outcome (prize) appear on the display character and that the indicium be displayed when the display character is in the second of two separate positions, Applicants respectfully submit that neither Fey nor Baerlocher, either alone or in combination, disclose or

suggest the required elements of the claimed invention, and a *prima facie* case of obviousness has not been established since “... all the claim limitations must be taught or suggested by the prior art ...” (see MPEP 2143.03). Therefore, Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

3. Double Patenting

The Office previously contended that the pending claims “conflicted with claims 1-19 of Application Serial No. 11/239,784” and cited 37 CFR §1.78(b), i.e., allegedly, the claims were not patentably distinct from each other. Applicants respectfully traverse the double patenting rejection and submit that the currently amended independent claims (1, 33 and 45) and corresponding dependent claims are patentably distinct from claims 1-19 of Application Serial No. 11/239,784. Accordingly, Applicants respectfully request that the double patenting rejection be withdrawn.

4. Co-pending Application

Applicants also wish to bring to the Office’s attention the existence of a related co-pending application, U.S. Application Serial No. 12/120,435 (filed May 14, 2008), which is a divisional application of the currently pending application.

SUMMARY

Applicants respectfully submit that the Amendments and Argument presented above have overcome the previous rejections and that the claims are in condition for allowance. If the Examiner has any questions regarding the application or this Amendment, the Examiner is encouraged to call the Applicants' attorney, Ian F. Burns, at (775) 826-6160.

Respectfully submitted,

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